REMARKS

This is a full and complete response to the Office Action mailed July 27, 2005. Prior to entry of the present amendment, Claims 1-18 were pending in this application. The undersigned attorney thanks Examiner Le for a careful review of this patent application, and for the indication of the allowability of Claims 16-18. *Office Action* at p. 6. The Examiner has rejected Claims 1-15 under 35 U.S.C. § 103. By the present response, Claims 19-23 have been added. Furthermore, the Assignee respectfully traverses the Office Action rejections for the remaining claims, and requests entry of the above amendments and following remarks set forth in this response.

Based on the following remarks, Applicants respectfully request reconsideration and allowance of all of the pending claims, which are patentable as well for the reasons discussed below.

I. SUMMARY OF THE AMENDMENTS

Claims 19-23 are hereby added.

II. CLAIM REJECTIONS

Under 35 U.S.C. § 103(a)

The Examiner has rejected claims 1-15 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Publication No. 2004/0052212 to Baillargeon ("***Baillargeon***") in view of U.S. Publication No. 2004/0087305 to Jiang et al ("***Jiang***"). Applicant respectfully traverses this rejection and requests reconsideration and withdrawal thereof.

The Examiner has the burden of establishing a *prima facie* case of obviousness when rejecting claims under 35 U.S. C. 103(a). The CAFC (and the CCPA before it) has repeatedly held that, absent some teaching or suggestion in a primary reference supporting a modification or combination of references, an arbitrary modification of the primary reference or combination of references is improper. *ACS Hospital Systems, Inc. v. Montefiore Hospital*, 732 F.2d 1572, 1577 (Fed. Cir. 1984). *In re Geiger*, 815 F.2d 686, 688 (Fed. Cir. 1987). Each of the Examiner's rejections will now be discussed in view of the above prevailing case law.

To establish *prima facie* case of obviousness, three criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the references or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art references when combined must teach or suggest all the claim limitations. *See e.g., In re Dembiczak*, 175 F.3d 994 (Fed. Cir. 1999); *In re Rouffet*, 149 F.3d 1350, 1355 (Fed. Cir. 1998); *Pro-Mold & Tool Co. v. Great Lakes Plastics, Inc.*, 75 F.3d 1568, 1573 (Fed. Cir. 1996). *See* MPEP. § 2142.

The Office Action has failed to make out a prima facie case of obviousness, because the cited references do not teach or suggest all of the claim limitations, either alone or in combination. The Examiner states correctly that ***Baillargeon*** fails to teach if the session requested was not successfully established, the mobile station automatically generating and transmitting a new session request, the new session request indicating an alternative data bearer for the call. However, the Office Action asserts it would be obvious to combine ***Baillargeon*** and ***Jiang*** in order to direct cellular network traffic. This argument falls short in part because the cited text of ***Jiang*** (Figure 6 and paragraphs 0088, 0089) also fails to teach or suggest if the session requested was not successfully established, the mobile station

automatically generating and transmitting a new session request, the new session request indicating an alternative data bearer for the call. As the cited text of ***Jiang*** discloses, if a roamer is not on a preferred network (608), a hard redirection process (612) causes mobile station to switch to a preferred network (see paragraph 0092). Clearly, ***Jiang*** discloses switching the network and not selecting an available data bearer, and significantly, the switching in ***Jiang*** is conditioned on the order of preference. In contrast, Claim 1 recites selecting an available data bearer conditioned on successful establishment of a session.

Furthermore, neither reference discloses automatically selecting an available data bearer for a data call initiated by a mobile station, as recited by independent Claim 1. Rather, ***Baillargeon*** teaches "[i]n response to the indication of congestion of network resources, one of the wireless network controller and packet gateways adjusts packet data flow between the wireless network controller and the packet gateway" (***Baillargeon***, Abstract), and ***Jiang*** teaches "causing the roaming mobile station to initiate a registration attempt with a preferred network" (***Jiang***, Abstract). *Underlining added.*

For at least the foregoing reasons, independent Claim 1 is patentable over the cited references as are its dependent Claims 2-15. Accordingly, the rejection of Claims 1-15 should be withdrawn. The Applicant also advances the following arguments to traverse the rejections of Claims 2, 5, and 8 as additional grounds for allowance.

The Office Action incorrectly alleges that the combination of ***Baillargeon*** and ***Jiang*** teaches the method of Claim 2, wherein the trigger event is user interaction via a user interface, citing for support the following paragraphs of ***Jiang***:

> [0047] In some cases, the probes used to monitor the SS7 signaling link 314 may belong to a third party and the information exchanged with the TR network element 102 may use Files, Sockets, FTP, custom trigger etc. In yet other cases, a HPMN HLR 302 may initiate a trigger to an external application, such as the TR

> application or TR network element 102, on every Update Location message, as shown by path 315.
>
> [0072] The STK application 280 registers for three Event Download messages--Location Status, Call Connected and Call Disconnected. Every time the Location Area changes, the Location Status event is downloaded to the STK application 280. Similarly, for every MO and MT call, the Call Connected event is downloaded. When the call clears, the Call Disconnected event is downloaded to the STK application 280.

The cited text includes no teaching or suggestion of the invention of Claim 2.

The Office Action also cites paragraph 0020 of ***Baillargeon*** to support the contention that combination of ***Baillargeon*** and ***Jiang*** teaches the method of Claim 5, wherein generating the session request comprises generating a data string that includes at least one of the following data elements: a call type, information identifying an initial data bearer, and information regarding data to be accessed via the voice call. The cited text fails to teach or suggest these limitations, disclosing instead:

> [0020] The packet gateway 30 is identified as the primary packet gateway for the wireless network controller 26. In case of congestion or failure of the primary packet gateway 30, the wireless network controller 26 is further associated with a backup or secondary packet gateway 32.

With respect to Claim 8, the Office Action correctly indicates that the combination of ***Baillargeon*** and ***Jiang*** fails to teach comprising upon receiving the session status message, displaying information indicating whether the session requested was successfully established on a display component of the mobile station. To support the obviousness rejection of this claim, the Examiner has taken Official Notice that displaying information indicating whether the session requested was successfully established on a display component of the mobile station is known in the art. Office Action at p. 4. We traverse this rejection as a finding that is not supported by adequate evidence, as it is established that "[i]t would not be appropriate for the examiner to take official notice of facts without citing a prior art reference where the facts asserted to be well known are not capable of instant and unquestionable demonstration as being well-known."

MPEP § 2144.03. Taking Official Notice of the state of the art contravenes the holding of the CCPA in *In re Eynde*, 480 F.2d 1364, 1370, 178 USPQ 470, 474 (CCPA 1973) ("[W]e reject the notion that judicial or administrative notice may be taken of the state of the art. The facts constituting the state of the art are normally subject to the possibility of rational disagreement among reasonable men and are not amenable to the taking of such notice."). Moreover, the Examiner's rejection fails to consider the subject matter claimed as a whole, singling out the limitation added by Claim 8 rather than considering its subject matter in the context of its parent claim. It is established that:

> The test under § 103 is not whether an improvement or a use set forth in a patent would have been obvious or nonobvious. The test is whether the claimed invention, considered as a whole, would have been obvious or nonobvious. 35 U.S.C. § 103; *Carl Schenck, A.G. v. Nortron Corp.*, 713 F.2d 782, 785, 218 USPQ 698, 700 (Fed. Cir. 1983). Failure to consider the claimed invention as a whole is an error of law. *W. L. Gore, supra*, 721 F.2d 1540, 220 USPQ at 309 (error in considering claims in less than their entireties).

Jones v. Hardy, 727 F.2d 1524, 1529 (Fed. Cir. 1984). For at least this additional reason, the rejection of Claim 8 is improper and should be withdrawn.

III. NEW CLAIMS

Claims 19-23 also define the present invention over the cited references. Support for these claims may be found throughout the specification, claims, and drawings as originally filed; therefore, the Applicants respectfully submit that no new matter has been added.

IV. PRIOR ART MADE OF RECORD BUT NOT RELIED UPON

The pending claims are also patentable over the references the Office Action cited but did not rely upon.

U.S. Publication No. 2005/0009516 to Stumpert et al teaches set-up of a connection between a communication system with separated call control and bearer control.

U.S. Publication No. 2002/0029275 to Selgas relates to network connections, such as the Internet, and allows systems to be independently, transparently and dynamically connected or reconnected to a network based upon any number of attributes such as user or group identity, cost, availability, reliability, etc.

U.S. Publication No. 2004/0147285 to Urien teaches method for managing transmissions of multimedia data via an internet-type network between a first subscriber system and a second subscriber system including at least one phase of signaling data exchange, via a signaling channel, with the aid of a predetermined signaling protocol, and a phase of exchanging said multimedia data via a data channel, with the aid of a predetermined communication protocol.

None of these references disclose, teach, or suggest systems or methods enabling a mobile station to automatically select an available data bear for a data call over a wireless network.

V. CONCLUSION

For at least the above reasons, the claims presented in this application are patentable over the cited references. Applicant respectfully request timely allowance of these claims and issuance of a patent in due course.

A petition for extension of time is submitted herewith, along with the appropriate fee.

Should the Examiner believe that a telephone conference would be useful, please contact the undersigned at the telephone number listed below.

Respectfully submitted,

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